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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,663	09/19/2001	David M. Roche	19629-7006	1221

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EXAMINER

LY, CHEYNE D

ART UNIT PAPER NUMBER

1631

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

5.19.

Office Action Summary

Application No.

09/955,663

Applicant(s)

ROCKE ET AL.

Examiner

Cheyne D Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 03, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 03/02.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election without traversal the nucleic acid species, filed November 03, 2003, is acknowledged.
2. Claims 13 and 14 have been withdrawn due to being directed to non-elected subject matter.
3. Claims 1-12, nucleic acid species, are examined on the merits.

IDS

4. Document C1** has not been considered due to said document not being published.

CLAIM REJECTIONS - 35 U.S.C. § 112, SECOND PARAGRAPH

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Specific to step (g) of claim 1, the parameters utilized in the equations have not been defined. It is noted that steps (b) and (e) define parameters similar to parameters being used in the equation of step (g), however, the parameters of steps (b) and (e) are not exactly the parameters being used in the equation due to the presence or absence of the symbols such as circumflex symbols or cap-like symbols on top of the parameters in the equation. Claims 2-12 are rejected for being dependent from claim 1.
8. Specific to claim 1, step (g), the equation following the term "where" causes the claim to be not commensurate in scope with the specification. The equation following the term "where"

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of said step has not been found in the specification. Claims 2-12 are rejected for being dependent from claim 1.

9. Specific to claims 3 and 4, step (c), the recitation of "X" causes the claim to be vague and indefinite because it is not clear whether "X" is a variable or a mathematical operation.

Clarification of the metes and bounds is required.

LACK OF ENABLEMENT UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention.

12. Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in *Ex parte Forman*, 230 USPQ 546 (BPAI 1986) and reiterated by the Court of Appeals in *In re Wands*, 8 USPQ2d 1400 at 1404 (CAFC 1988). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2) the amount or direction presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. The Board also stated that although the level of skill in molecular biology

is high, the results of experiments in genetic engineering are unpredictable. While all of these factors are considered, a sufficient amount for a prima facie case is discussed below.

13. Claim 1 recites a method for estimating the precision of measurements. However, the instant specification lacks any guidance as to how one of skill in the art to use the estimated precision of measurement generated by the method of the instant invention. It is acknowledged that the instant specification discloses the equation of step (g) and the parameters being used in said equation (pages 13-14); however, said specification does not disclose what type of measurements are being represented by the parameters. For example, the specification discloses equation 19 (page 14) as directed to generic measurements and values. One question comes to mind is what measurements or values are being applied to equation 19 for the estimating the precision of measurements. Due to the high level of skill requirement and the lack of guidance how one of skill in the art for determining what type of measurements are to be used with the equation of step (g), one of skill in the art to would not be able to practice the instant invention without undue experimentation.

14. Claims 3 and 4, step (c), recite a step for the variable c wherein c is equal or greater than 2, and equal or less than 3. Further, it is acknowledged that the specification discloses the used of the instant invention where in c is 2.5 and 3 (page 13, line 10). However, the specification does not provide any disclosure of how the value of 2.5 or 3 is determined. The instant specification does not provide adequate guidance to one of skill in the art to determine the value of c to practice the claimed invention without undue experimentation.

CONCLUSION

1. NO CLAIM IS ALLOWED.

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15. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 872-9306.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (703) 308-3880. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

18. Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

C. Dune Ly
1/8/04


ARDIN H. MARSCHEL
PRIMARY EXAMINER